

REMARKS

Applicant thanks the Examiner for withdrawing the rejections of claims 7-16 as being anticipated by or, in the alternative, obvious over Shore and under 35 USC 251 for containing new matter.

The undersigned apologizes for the failure of applicant's previous response to respond to the formal issues raised by the Examiner. For example, new claims 7-16 are now underlined, and applicant has withdrawn the specification amendment presented in the Preliminary Amendment of October 23, 2003, as it is unnecessary. As the undersigned understands the format rules, it is not necessary for the reissue claims to be labeled as "(New)." Applicant submits herewith his Second Supplemental Reissue Declaration and Power of Attorney, which overcomes the informalities noted by the Examiner, clarifies the error to be corrected by reissue and appoints new attorneys.

Claims 7-16 have again been rejected under 35 USC 251 as constituting an improper recapture of broadened claimed subject matter surrendered in the original patent prosecution. This rejection is respectfully traversed. Furthermore, since the Examiner failed to follow the MPEP in making this rejection as explained below, the finality of the pending Action is premature until the Examiner provides the analysis required by the MPEP.

It appears from the Action that the issues before the Examiner pertaining to this rejection were not correctly framed by applicant in the previous response, for which applicant apologizes. In this response, applicant believes that the issues are correctly framed and that, as a result, the propriety of this reissue application as to new claims 7-16 will become apparent.

First, the Examiner is quite right to observe that failing to file a timely divisional application is not an error that is correctable by reissue. However, claims 7-16 do not relate to the subject matter that was withdrawn from consideration in the original prosecution. The non-elected claims, application claims 40-42, were directed to boron nitride powder particles coated with a coating layer containing an alkali borate. The elected claims, claims 1-39, included

method claims 1-24 and product claims 25-39. Claims 7-16 in this application are not directed to the subject matter of claims 40-42 and are instead consonant with originally elected claims 25-39. Therefore, it was confusing for applicant to have raised this issue, which has been rectified in the supplemental reissue declaration submitted herewith.

Second, assuming that the cancellation of claims 67-81 constitutes “surrender” of their subject matter, a point which applicant respectfully declines to concede, applicant respectfully submits that the Examiner has not correctly applied the test for deciding if a broadening reissue constitutes improper recapture of surrendered subject matter. As set forth in MPEP 1412.02, the test asks the following questions:

- (1) Was there broadening of the reissue claims as compared with the patent claims?
- (2) Does any broadening aspect of the reissue claim relate to the surrendered subject matter?
- (3) Were the reissue claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?

In neither the pending Action nor the prior Action did the Examiner follow the procedure set forth in the MPEP, and, by failing to do so, has deprived applicant of a full opportunity to respond to the rejection. As to Question (1), applicant agrees that reissue claims 7-16 are broadened with respect to original claims 1-6 since the reissue claims could be infringed without infringing the original claims. However, the Examiner’s logic does not deal with the substance of Questions (2) and (3) as explained in the MPEP.

The Examiner says on page 2 of the pending Action that “[t]he record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim[ed] subject matter that applicant previously surrendered during the prosecution of the application.” The Examiner said exactly the same thing, no more, in the first Action on this application. Although this statement ostensibly relates to answering Question (2) above, it falls far short of what the Examiner is required to do to support this rejection. As MPEP 1412.02.I.B.1 makes clear, the

Examiner must analyze “[a]ll of the broadening aspects of reissue claims * * * to determine if any of the omitted/broadened limitation(s) are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.” The pending Action and the first Action on this application present the language of rejection identically, without at all identifying which limitations of claims 7-16 were broadened with respect to any surrendered subject matter. For this reason alone, the statement of rejection is deficient and must be revised if the Examiner is to rely on this ground of rejection. The Examiner has totally failed to determine which limitations of the reissue claims in this application are broadened over the original claims and has failed to determine if any of those broadened limitations “are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.” Without such an analysis, applicant has nothing to respond to and thus has been deprived of the opportunity to join issue with the Examiner as to Question (2).

More importantly, applicant respectfully inquires as to whether the Examiner has, in fact, compared canceled claims 67-81 with reissue claims 7-16. The reason applicant says this is that the two sets of claims are not much alike at all. For example, independent reissue application claims 7 and 8 both refer to the claimed crystalline turbostratic boron nitride as exhibiting “a combined (10) diffraction peak in the X-ray powder diffraction diagram around the site of [100] and [101] diffraction peaks of hexagonal boron nitride, said combined (10) diffraction peak having a peak at a site which corresponds to the site of [100] diffraction of hexagonal boron nitride and exhibiting substantially no recognizable diffraction peak which corresponds to the [101] diffraction peak of hexagonal boron nitride.” There is nothing in claims 67-81 that remotely corresponds to this limitation, and there is nothing in the original prosecution that pertains to such a limitation. Therefore, the Examiner’s insistence on the surrender of the subject matter of claims 67-81 does not respond to Question (2) at all. There is no recapture here.

Finally as to Question (2), the statement from MPEP 1412.02 quoted above demonstrates that an important piece of the Examiner’s logic, that the cancellation of claims 67-81 constituted

surrender of all their subject matter, is not germane to the analysis. The MPEP correctly requires the Examiner to determine if any of the broadened limitations were “directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.” The phrase “the claims” must refer to the original patent claims, not to claims that might have been canceled during prosecution, since canceled claims are by nature not made “allowable over the art” during the original prosecution. Thus, since claims 67-81 were canceled, applicant could not have been relying on limitations in those claims to make the original patent claims allowable over the prior art. The Examiner has applied a definition of “surrender” in his treatment of Question (2) that does not fit the MPEP’s directions as to the proper analysis to be conducted.

On Question (3), it is apparent from a comparison of reissue claims 7-16 that they are narrower than original claims 1-6 in aspects that would compensate for any recapture, as discussed above with respect to Question (2), so they are allowable.

Applicant has not overlooked the discussion in the paragraph bridging pages 2 and 3 of the Action. However, applicant respectfully submits that this discussion falls short of what MPEP 1412.02 requires. In particular, the Examiner failed to identify what “the broader aspect of the reissue claims” happens to be, depriving applicant of a chance to join issue; merely stating that “claims 67-81 in the original application were surrendered in their entirety” does not respond to Question (2) of the MPEP test. Finally, the Examiner’s argument that the omission of the limitation that the product was produced by one of the methods of claims 43-48 constitutes improper recapture, even if correct, fails to satisfy Question (3). As pointed out above, claims 7-16 of this reissue application do not correspond to original application claims 67-81 as the Examiner apparently thinks they do.

Accordingly, the rejection of claims 7-16 under 35 USC 251 for improper recapture of surrendered subject matter should be withdrawn, both because the Examiner failed to conduct the


inquiries mandated by MPEP 1412.02 and because the proper analysis shows that there is no recapture.

Early action allowing claims 1-16 is solicited. If this response contains any formal error that may be overcome by amendment, the Examiner is respectfully requested to telephone the undersigned to discuss such amendments.

In the event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 251002008830.

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Respectfully submitted,

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